

REMARKS

The Official Action of October 9, 2007, and the documents applied as alleged prior art have been carefully reviewed. The claims in the application remain as claims 11-28, and these claims define patentable subject matter warranting their allowance. The applicants therefore respectfully request favorable reconsideration and allowance.

Acknowledgement by the PTO of the receipt of applicants' papers filed under Section 119 is noted.

Claims 2-7 and 14-16 have been rejected under the second paragraph of Section 112. The rejection is respectfully traversed.

Applicants believe that the claims as previously drafted, particularly when considered in light of applicants' specification (consistent with the law), would not have been confusing to those skilled in the art, and therefore the claims in their previous form are fully in accordance with Section 112. At **worst**, claims 2-7 and 14-16 in their previous forms might be considered objectionable, but **only** as to form, requiring no substantial amendments relating to patentability.

Nevertheless, in deference to the examiner's views and to avoid or minimize needless argument, a number of cosmetic amendments have been made. The amendments are of a formal nature only, i.e. made to place the claims in improved

form for U.S. practice. The amendments are not "narrowing" amendments because the scope of the claims has not been reduced. No limitations have been added and none are intended.

As regards claims 2 and 6, antecedent basis need not be perfect, MPEP 2173.05(e). As regards claim 14, applicants are not clear why the examiner finds the criticized phrase to be unclear. Nevertheless, applicants believe that the amendments made above, again made in deference to the examiner's views, should obviate any problems.

Withdrawal of the rejection is in order and is respectfully requested.

No other rejections have been imposed under Section 112, and no objections to the claims have been made. Applicants are proceeding in reliance thereof.

The PTO has objected to the Abstract as not commencing on a separate sheet. Applicants do not understand this objection. Attached is a copy of page 37 of the application which shows the entire Abstract on page 37, i.e. it both begins (commences) and ends on page 37.

If this objection is to be repeated, applicants would respectfully request clarification.

Claims 1-3, 6-10 and 12-28 have been rejected under Section 102(e) as anticipated by Takahashi et al USP 5,562,454 (Takahashi). This rejection is respectfully traversed.

First, applicants believe that Takahashi does not qualify as "prior art" under any part of Section 102, and applicants therefore respectfully submit that a rejection cannot properly be based on Takahashi under Section 102(e). The present application is a CIP of PCT/JP02/07172, filed July 15, 2002, and claims priority from an application filed in Japan on July 16, 2001, whereas Takahashi, insofar as it is "prior art", is only entitled to its filing date of December 4, 2001, subsequent to applicants' priority date.

For the record, applicants also respectfully note that the subject matter of Takahashi and the claimed invention were, at the time the present invention was made, commonly owned by Yupo Corporation or subject to an obligation of assignment to Yupo Corporation, and therefore 35 U.S.C. 103(c) also comes into effect.

Second, even if Takahashi were "prior art" contrary to applicants' position as indicated above, Takahashi still would not anticipate any of applicants' claims, let alone all of claims 1-3, 6-10 and 12-28. In this regard, the present invention is directed to a forgery-preventing film, whereas Takahashi discloses something quite different, namely an integrated circuit (IC) tag or label having an IC encapsulated

therewithin, the IC comprising a wiring circuit and an IC circuit for the transmission and reception of data (column 1, lines 6-9 of Takahashi). No forgery-preventing film as set forth in claim 1 is disclosed in Takahashi.

The PTO takes the position that the phrase "for forgery-prevention" is only an intended use which (presumably) the PTO feels it may ignore or brush aside. Similarly, the PTO takes the position that the preamble language "forgery-preventing film" may also be ignored or brushed aside, or at least given no weight. Applicants strongly traverse the position of the PTO in these regards.

Applicants respectfully note that the introductory language of claim 1, namely a "forgery-preventing film", defines what the article is, and is not an intended use. In this regard, the examiner's attention is respectfully invited to *In re Stepan et al*, 156 USPQ 143, 147. Here, the preamble of claim 25 read as follows:

25. An acid phosphate of a
condensation product of... .

The appellants argued that the expression "condensation product" defined "what the acid phosphate is", and the Court reversed the rejection. Also see the somewhat analogous case of *In re Garner*, 162 USPQ 221, 223, where in effect the Court held that the claim language "interbonded one to another by interfusion" defined the structure of the product. See also *In*

re *Bulloch et al*, 203 USPQ 171, 174 (CCPA 1979), where the court stated:

The introductory claim language "stable color developer concentrate" is more than a mere statement of purpose; and the language is essential to particularly point out the invention defined by the claims. See *Kropa v. Robie*, ... 88 USPQ 478 (1951);....

There should be no doubt that, as a general rule, all subject matter recited in a claim must be given full weight; and, consequently, any rejection based on anticipation requires that the reference relied upon show each and every feature claimed in a coherent fashion. A sometimes exception is when the claim preamble only calls for an intended use. The leading case in this area as correctly noted in the Office Action is *Kropa v. Robie*, *supra* (CCPA 1951).

In *Kropa v. Robie*, the court reviewed thirty seven of its own prior decisions in cases where it had determined whether or not the claim preamble must be given effect. The court stated:

...., in those *ex parte* and interference cases where the preamble to the claim or count was expressly or by necessary implication given the effect of a limitation, the introductory phrase was deemed essential to point out the invention defined by the claim or count. In the latter class of cases, the preamble was considered necessary to give life, meaning and vitality to the claims or counts. Usually, in those cases, there inhered in the article specified in the preamble a problem which transcended that before prior artisans and the solution of

which was not conceived by or known to them. The nature of the problem characterized the elements comprising the article, and recited in the body of the claim or count following the introductory clause, so as to distinguish the claim or count over prior art.

The same situation exists in the present case. Particular problems exists in the environment of forgery prevention which are made clear in applicants' specification, which problem has nothing to do with Takahashi.

In other words, using the language of *Kropa v. Robie*, inherent in a forgery-preventing film as recited in claim 1 is the solution of "a problem which transcended that before prior artisans and the solution of which was not conceived by or known to them". The introductory clause is therefore "essential to point out the invention defined" by the remainder of applicants' claims, such remainder then tying back to the preamble by reciting that the fares of the product have been "processed for forgery prevention", a recitation of a physical property of the structure, or physical state of the claimed product.

The introductory clause of claim 1 defines what the claimed device is, and the examiner may wish to consider some cases which are more recent than *Kropa v. Robie*. Attention is therefore first invited to *Perkin-Elmer v. Computervision*, 221 USPQ 669, 675 (Fed. Cir. 1984), where the introductory clause of claim 1 called for a "unity magnification catoptric image-

forming system... ." In giving weight to such recitation, the court stated:

The system of claim 1 is one of unity magnification and is image forming. Those limitations appear in the preamble, but are necessary to give meaning to the claim and properly define the invention. [citations omitted]

In *Loctite v. Ultraseal*, 228 USPQ 90, 91-93, the introductory portion of claim 1 of the '012 patent read as follows:

1. An anaerobic curing sealant composition adapted to remain in a liquid, non-polymerizing state... .

The court stated:

Although it appears in the preambles of the '012 patent claims, the term "anaerobic" breathes life and meaning into the claims and hence is a necessary limitation to them. [citation omitted]

The holdings of the lower court were vacated, and the case was remanded.

Attention is next invited to *In re Stencel*, 4 USPQ2d 1071 (Fed. Cir. 1987) where the introductory clause of claim 1 called in part for a "driver for setting a joint of a threaded collar, ... the collar having plastically deformable lobes on its longitudinal exterior ..., the driver comprising:". In reversing the rejection, the Court stated:

We conclude that it would not have been obvious to [provide the applicant's

invention] unless one had in mind the purpose taught by appellant. This purpose, set forth in the claims themselves, "is more than a mere statement of purpose; and that language is essential to particularly point out the invention defined by the claims." [citations omitted; bracketed material added]

Similarly, in the present case, the purpose of the present applicants is not to be found in Takahashi; this purpose, set forth in applicants' claims, "is essential to particularly point out the invention defined by the claims".

Lastly, attention is respectfully invited to *Corning Glassworks v. Sumitomo Electric*, 9 USPQ2d 1962, 1965-66 (Fed. Cir. 1989). Here, claim 1 of the '915 patent recited an "optical wave guide comprising... ." The Court stated:

In this case, the question of anticipation turns on claim interpretation, [citation omitted] If the claims are given Sumitomo's suggested interpretation, the [prior art] patent anticipates [claims 1 and 2 of the '915 patent]; otherwise, it does not. In particular, the dispute focuses on the interpretation and effect of the words "An optical wave guide" in claim 1. [bracketed words added]

Sumitomo argued that the fiber of the prior art patent could "inherently" function as a "waveguide", and therefore the words "An optical waveguide" should be ignored because

"the preamble is not a limitation when it merely states a purpose or *intended use* and the remainder of the claim completely defines the invention". (Italics in the court decision)

In affirming the lower court's decision of validity (no anticipation), the Federal Circuit stated in part as follows:

The effect preamble language should be given can be resolved only on review of the entirety of the [disclosure] to gain an understanding of what the inventors actually invented and intended to encompass by the claim. Here, the 915 specification makes clear that the inventors were working on the particular problem of an effective optical communication system not on general improvements in conventional optical fibers. To read the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorced from reality. The invention is restricted to those fibers that work as waveguides as defined in the specification, which is not true with respect to fibers constructed with the limitations of paragraphs (a) and (b) only. Thus, we conclude that the claim preamble in this instance does not merely state a purpose or intended use of the claimed structure [citation omitted]. Rather, those words do give "life and meaning" and provide further positive limitations to the invention claimed [citations omitted]. Thus, contrary to Sumitomo's argument, the core and cladding limitations set out in paragraphs (a) and (b) are not the only limitations of the claim [citation omitted]. The claim requires, in addition, the particular structural relationship defined in the specification for the core and cladding to function as an optical waveguide.

Similarly, the introductory clause of applicants' claim 1 is also a requirement of applicants' invention. The Federal Circuit continued:

Viewed in this manner, the fact that the [prior art] luminescent fiber could inherently transmit information for a few meters becomes irrelevant. The [prior art] patent does not disclose all the limitations of the claimed "optical waveguide" as that term is structurally defined by the '915 inventors.

The examiner should be guided by the above quoted words of the Federal Circuit from *Corning Glass Works v. Sumitomo Electric*.

Takahashi, even if it were prior art, would not anticipate claims 1 and 2, and therefore Takahashi would not anticipate any of applicants' claims. The rejection should be withdrawn and such is respectfully requested.

As regards claims 2, 3 and 7, they depend from and incorporate the subject matter of claim 1, and so are patentable for the reasons given above.

As regards dependent portions of these claims, the PTO takes the position that "it is inherent [in Takahashi] for the shielding layer to be shaded, which is invisible by reflected light and visible by transmitting light and for the light part of the material to have a dot ratio from 5-70 %, as in claims 2-3 and 7." Applicants strongly traverse such reliance on alleged inherency.

For a rejection under Section 102 to be based on inherency, such inherency must be reasonably certain, and may not be established only by probabilities or possibilities. Stated another way, inherency requires that the missing characteristic be necessarily present. See for example *Crown Operations International Ltd. v. Solutia Inc.*, 62 USPQ2d 1917, 1923, a case involving a patent directed to a layered product, in this case a metal-coated substrate. Quoting from *Contential Can v. Monsanto*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991), the Court stated:

Inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." [Contential Can] at 1749 (quoting *In re Oelrich*..., 212 USPQ 323, 326 (CCPA 1981)).

See the same quote in *In re Robertson*, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999).

Please also consider *In re Brink*, 164 USPQ 247, 249, where the court stated:

Absent a showing [by the PTO] of some reasonable certainty of inherency, the rejection... under 35 U.S.C. 102 must fail.

And from *ex parte Cyba*, 155 USPQ 756, 757 (1967):

In order that a rejection based upon inherency may be sustained, such inherency must be certain.

And on the issue of the burden being on the PTO, please see *Ex parte Levy*, 17 USPQ2d 1461, 1463-64:

..., the initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention rests upon the examiner. [citation omitted]. In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic ***necessarily*** flows from the teachings of the prior art. [citations omitted; italics in original]

Inherency is not established, as it is not reasonably certain in Takahashi and does not necessarily flow from Takahashi's disclosure.

Thus, yet another reason exists for the allowance of claims 2, 3 and 7.

As regards claim 18, the rejection states that "the phrase, 'outermost thermoplastic resin film is printable in any mode of electrophotography' constitutes a 'capable of' limitation and... such a recitation ... is not a positive limitation but only requires the ability to so perform." Thus, it appears that in affect the examiner has ignored, brushed aside, or refused to give any weight to the quoted recitation from claim 18. Applicants strongly disagree and traverse the PTO's conclusion in this regard.

For a thermoplastic resin film to be printable requires that it have certain physical characteristics. In

particular, it must have a surface which is capable of being printed, i.e. accepting and holding print, which is not the case for many thermoplastic materials, particularly certain polyolefins and other slippery thermoplastics which have not been specially surface treated to make them printable. The recitation in question, which the rejection brushes aside, therefore defines a physical characteristic and must be given weight.

Thus, another reason exists for the allowance of claim 18.

The rejection also brushes aside the dependent portion of claim 12 as being a so-called process limitation. While the process step itself cannot define the product, the effect of that process step can (and in this case does) properly define the product. Coatings which are vapor deposited have different physical characteristics than coatings applied in a different way, and therefore the fact that claim 12 calls for layer formed through vapor deposition of aluminum on the thermoplastic resin film means that such a layer has those particular characteristics.

Nevertheless, the structure of claim 12 has been revised to eliminate the process language and define the light-shielding layer as comprising vapor deposited aluminum.

Claim 12 is patentable not only because it depends from and incorporates the subject matter of patentable claim

1, but also because of the feature or features recited in the dependent portion thereof.

Again, withdrawal of the rejection under Section 102 is in order and is respectfully requested.

Claims 4, 5 and 11 have been rejected as obvious under Section 103 from Takahashi. This rejection is respectfully traversed.

As pointed out above, Takahashi is not available because, at the time the present invention was made, both it and Takahashi were owned by Yupo Corporation or subject to an obligation of assignment to Yupo Corporation; See 35 U.S.C. 103(c).

Simply for the record, applicants also note that even if Takahashi were available as prior art, it would not make obvious the features of claim 1. A disclosure of a tag or label containing an IC circuit as in Takahashi gives the person of ordinary skill in the art no reason to make modifications necessary to create a forgery-preventing film, even if such a person were to know of what those modifications might be.

Also for the record, applicants do not accept the alleged obviousness, in the absence of prior art, of the features as set forth in the dependent parts of claims 4, 5 and 11 which are admittedly not disclosed by Takahashi; and

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applicants reserve the right to further develop this point in the future if it should become necessary or desirable.

Withdrawal of the rejection is in order and is respectfully requested.

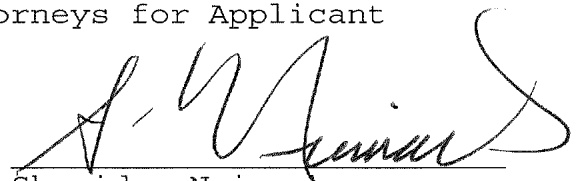
The prior art documents of record and not relied upon by the PTO have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently material to warrant their application against any of applicants' claims.

Applicants believe that all issues raised in the Official Action have been addressed above in a manner that should lead to patentability of the present application. Favorable consideration and early formal allowance are respectfully requested.

Respectfully submitted,

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